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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,504	01/06/2004	Toshio Sato	247244US3	3325
22850	7590	09/29/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			WATSON, ROBERT C	
			ART UNIT	PAPER NUMBER
			3723	
DATE MAILED: 09/29/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/751,504

Applicant(s)

SATO ET AL.

Examiner

Robert C. Watson

Art Unit

3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 7-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 15-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/13/04, 4/1/04.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

The IDS's of 2/13/04 and 4/1/04 list US application numbers. Since a US application is not prior art these items have been lined through on the PTOL-1449 by the examiner.

Applicant's remarks concerning the election of species requirement have been given careful consideration. In particular applicant's contention that "large number of subclasses can be searched without additional burden by electronic searching without substantial burden" is found to be unsound reasoning. The burden for searching a subclass whether by paper searching or by electronic searching is an identical burden since the same number of patents in a subclass must be searched with either method. In the instant case because of the mutually exclusive characteristics of the two distinct species additional subclasses must be searched for each species hence the multiple species in this application present a substantial burden to the Office. The restriction requirement is deemed proper and is hereby made FINAL.

In claims 6 and 19 the use of quotation marks is improper. Revision of these claims is required to eliminate the quotation marks.

Claims 1-6 and 15-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 5 the phrase "worm to be driven" is vague and indefinite. It is unclear whether or not a worm driving means is being claimed. If a worm driving means is not being claimed then the claim does not present a complete operative

device since the subsequent "contact of the clamping arm with the workpiece" could not take place.

Claims 7-14 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 9/12/05.


Lovrenich is cited to show an analogous worm driven clamp.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert C. Watson whose telephone number is 571 272-4498. The examiner can normally be reached on Mon. - Thurs. , 5:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph J. Hail III can be reached on 571 272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

rcw



**ROBERT C. WATSON**  
**PRIMARY EXAMINER**



LIST OF RELATED CASES

<u>Docket Number</u>	<u>Serial or Patent Number</u>	<u>Filing or Issue Date</u>	<u>Inventor/ Applicant</u>
<del>247244US3*</del>	<del>10/751,504</del>	<del>01/06/04</del>	<del>SATO et al.</del>
<del>245390US3</del>	<del>10/706,085</del>	<del>11/13/03</del>	<del>SATO et al.</del>

Robert C. Watson

9/25/04

\*Present Application; listed for information  
GJM/ae/gyy  
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POL-1999



**LIST OF RELATED CASES**

<u>Docket Number</u>	<u>Serial or Patent Number</u>	<u>Filing or Issue Date</u>	<u>Inventor/ Applicant</u>
<del>243676US3</del>	<del>10/680,113</del>	<del>10/08/03</del>	<del>SATO et al.</del>
<del>247244US3*</del>	<del>10/751,504</del>	<del>01/06/04</del>	<del>SATO et al.</del>

Robert C. Water

9/26/05

\*Present Application; listed for information  
GJM/akh  
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POL-1499